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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,177	03/12/2004	Lewis B. Aronson	060900-5000-US	8613

24341 7590 10/22/2004

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EXAMINER
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LEUNG, CHRISTINA Y

ART UNIT	PAPER NUMBER
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2633

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/800,177	Applicant(s) ARONSON ET AL.	
	Examiner Christina Y. Leung	Art Unit 2633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12 March 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 17-48 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 67-98 of copending Application No. 09/777,917. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 17-48 (including independent claims 17, 24, 25, 32, 33, 40, 41, and 48) of the present application are identical (word for word) to claims 67-98 (including independent claims 67, 74, 75, 82, 83, 90, 91, and 98) of 09/777,917 respectively. Therefore, these claims in the two applications are directed to identical inventions.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 67-82 respectively of copending Application No. 09/777,917 in view of King et al. (US 5,812,572 A).

Claims 1-16 of the present application (including independent claims 1, 8, 9, and 16) are substantially similar to claims 67-82 (including independent claims 67, 74, 75, and 82) of 09/777,917 respectively. Claims 1-16 of the present application differ from claims 67-82 of '917 in that in each of the independent claims (claims 1, 8, 9, and 16), a host is enabled to "read directly from and write directly to locations within the memory," whereas the independent claims 67, 74, 75, and 82 of '917 recite that a host is enabled to read from memory locations but do not specifically recite that the host is also enabled to write to memory locations.

However, King et al. teach a system and method for monitoring an optoelectronic device (Figure 1) including an interface (serial port 26) enabling a host to read and write from memory (in microcontroller 50; column 16, lines 59-67). Given the apparatus and method already recited in claims 67-82 of '917, it would have been obvious to a person of ordinary skill in the art to further include allowing the host to write to memory as taught by King et al. in order to allow the host to change the stored parameters in the system and provide adjustments to the controller circuitry.

This is a provisional obviousness-type double patenting rejection.

***Allowable Subject Matter***

5. Claims 1-48 contain allowable subject matter, but claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting and claims 17-48 are provisionally rejected under 35 U.S.C. 101. No claims are currently allowed.

6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art, including King et al., does not disclose or fairly suggest a system or method including the combination of all elements or steps as recited in independent claims 1, 8, 9, 16, 17, 24, 25, 32, 33, 40, 41, and 48 of the present application.

King et al. generally disclose a circuit for controlling an optoelectronic device (Figure 1) including memory 50, analog to digital conversion circuitry 52, and control circuitry (such as modulation current adjust element 24), and further disclose monitoring power level values and temperature values by way of making a comparison between inputs and limit values (column 16, lines 24-38). They also generally disclose a host interface (serial port 26). However, they do not specifically further suggest comparison logic for comparing the digital values corresponding to

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operating conditions of the device with limit values in order to specifically generate flag values, wherein the flag values are specifically stored in predefined locations within the memory during operation of the optoelectronic device and wherein an interface allows a host to directly read from those predefined flag storage locations in memory.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Y. Leung whose telephone number is 571-272-3023. The examiner can normally be reached on Monday to Friday, 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 571-272-3022. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christina Y Leung  
Christina Y Leung  
Patent Examiner  
Art Unit 2633